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REMARKS

Claims 19-28 and 30-40 are all the claims pending in the application. Claims 1-18 and 29 have been canceled without prejudice or disclaimer. New claims 36-40 have been added to further define the invention. Reconsideration and allowance of all the claims are respectfully requested in view of the following remarks.

Information Disclosure Statement (IDS)

The Examiner has not considered SU 3 943 191, because he asserts that it “was not filed in either application 09/859,044 or 09/471,232.”¹ However, contrary to the Examiner’s assertion, this reference was made of record during the prosecution of both parent application Nos. 09/859,044 (hereinafter the ‘044 application) and 09/471,232 (hereinafter the ‘232 application).

In an Office Action mailed on May 9, 2001,² in the ‘232 application, Examiner N. Fayyaz cited on a PTO-892 document number “3,943,191” published “12/1986” from the country of “Russia” in the name of “Shvartsman”. Together with this PTO-892, the Examiner provided a copy of the reference document number “1985 SU-3943191” dated “08/1985” in the name of “Shvartsman”. It is believed that the Examiner mistakenly identified “Russia” instead of “Soviet Union” as designated by the “SU” country code on the copy of the reference as provided.

In the ‘044 application, filed as a divisional of the ‘232 application, Applicants cited document “3,943,191” dated “12/1986” from the country of “SU” in an attempt to correct Examiner Fayyaz’s apparent error. In an Office Action mailed on March 31, 2003,³ Examiner Katherine A. Bareford considered and initialed next to this document as cited on the PTO form-

¹ Office Action at page 2, item 1.

² A copy of this Office Action, together with the reference as provided by the USPTO, is submitted herewith for the Examiner’s convenience.

³ A copy of this Office Action is submitted herewith for the Examiner’s convenience.

1449 submitted in the '044 application listing all the references cited during prosecution of the '232 application.

Therefore, to be consistent with the '044 application and again to correct Examiner Fayyaz's apparent error, on the PTO form-1449 submitted on October 6, 2003 in the present application, Applicants cited the reference as document "3,943,191" published "12/1986" from the country of "SU".

In light of the above, Applicants respectfully request that the Examiner consider and initial next to the document "3,943,191" published "12/1986" from the country of "SU", as listed on the PTO form-1449 submitted October 6, 2003 in the present application.

Drawings

The Examiner asserted that Fig. 15 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. Applicants have submitted herewith one Replacement Drawing Sheet (14/14), wherein Fig. 15 is labeled as --Prior Art--.

Specification

The Examiner objected to the abstract of the disclosure as being more than 150 words. Accordingly, Applicants have amended the abstract of the disclosure so as to comply with the 150 word limit.

Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claims 19-35 under §112, 2nd paragraph, as being indefinite. Specifically, the Examiner asserted that the recitation "relatively approaching" is indefinite. Applicants have amended this phrase so as to recite that the application control unit "moves at least one of ... with respect to one another". Accordingly, this rejection is believed to have been overcome. These amendments to claims 19, 20, 27, and 29, were made merely to more accurately claim the present invention, do not narrow the literal scope of the claims, were not made for reasons of patentability and thus, do not implicate an estoppel in the application of the doctrine of equivalents.

Allowable Subject Matter


Applicants thank the Examiner for indicating that claims 20, 25, 26, 29, 34, and 35, would be allowable if rewritten in independent form and to overcome the rejections under § 112, 2nd paragraph. In order to expedite prosecution of this application, Applicants have: written claim 20 in independent form by incorporating the subject matter thereof into claim 19; written claim 29 in independent form by incorporating the subject matter thereof into claim 27; and have written claim 25 in independent form as new claim 36. Additionally, new claims 37-40 have been added as dependent from new claim 36. Further, as noted above, the rejection under § 112, 2nd paragraph, is believed to have been overcome. Accordingly, claims 19-28 and 30-40 should be in condition for immediate allowance.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Jeffrey A. Schmidt
Registration No. 41,574

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: July 14, 2004



3101V
**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

00/171,232 11/23/99 SERINE

057-001

MM/1/0504
JENNIFER M. LINN MACPEAK & SEAS PLLC
2100 PENNSYLVANIA AVENUE N.W.
WASHINGTON DC 20037

EXAMINER

FAYYAZ, N	
ART UNIT	PAPER NUMBER

2856
DATE MAILED: 12-12-01

DOCKETED
MAY 11 2001

064486

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



Office Action Summary

Application No.
09/471,232

Applicant(s)

Sekine et al

Examiner
Nashmiya Fayyaz

Art Unit
2856



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 20, 2001
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) 1-12, 15, and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) is/are allowed.
- 6) ☒ Claim(s) 13, 14, 17, and 18 is/are rejected.
- 7) ☐ Claim(s) is/are objected to.
- 8) ☐ Claims are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. .
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). .
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

Art Unit: 2856

1. Applicant's election without traverse of Group II, species V in Paper No. 7 is acknowledged.
2. Claims 1-12, 15 and 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected Invention/species. Election was made **without** traverse in Paper No. 7.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 13, 14, 17, ^{and} ~~a~~ 18 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Smith et al. - US Patent #4,738,336.

As to claims 13, 14, 17 and 18, Smith et al. disclose a controlled lubrication replenishing system including bearing housing 12, with bearing sets 34/26 with rolling elements 18 in cage 20, sensor 32 with leds 40/42 and photo sensors 44/46, lubricant pump means 52 with discharge conduit 53 for pumping lubricant to bearing 24/26, and further a control system 54 monitors the speed ratio which is representative of the lubricant film thickness and controlling subsequent lubricant, see figs. 1-3 and col. 2, lines 61 et seq.

5. Claims 13, 14, 17 and 18 are rejected under 35 U.S.C. 102(b) clearly as being clearly anticipated by Yamada U.S Patent #5,076,397.

5/7/01
ZAS


Art Unit: 2856

As to claims 13, 14 17 and 19, Yamada discloses an oil lubricant condition sensing system for a bearing including shaft 14 in bearing 21 with lubricant continued in reservoir filled through opening 35 and further including sensor 41 with light emitter 43 and light receiver 44 and finally an oil conditioning deciding circuit 44, see col. 2, lines 55 et seq and Figs. 2-3.


6. Claims 13, 14, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by JP - 106196 - Kurokawa.

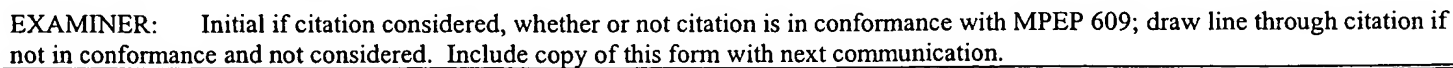
As to claims 13, 14, 17 and 18, Kurokawa discloses a lubricating oil supply supervising device including lubricant supply 1, feed pipe 3, bearing 2, light sensor 15, light source 17 and count, comparing portion 25 and judging portion 26 to judge whether oil is properly supplied to a portion to be lubricated see abstract and fig. 1.

7. Any inquiry concerning this communication should be directed to n. Fayyaz at telephone number (703) 308-4891.

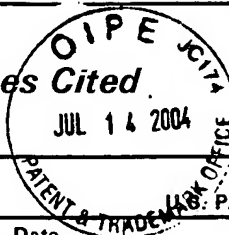

Fayyaz/ds

05/05/01


HEZRON WILLIAMS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800



Notice of References Cited



Applicant/Patent Sekine et al		Application/Control No. 09/471,232	
Examiner Nashmiya Fayyaz	Art Unit 2856	Page 1 of 1	

PATENT DOCUMENTS

	Document Number Country Code-Number-Kind Code	Date MM-YYYY ¹	Name	Classification ²	
A	4,152,598	5/1979	Stewart	250	391
B	4,738,336	4/1988	Smith et al	184	6.4
C	5,076,397	12/1991	Yamada	184	6.4
D					
E					
F					
G					
H					
I					
J					
K					
L					
M					

FOREIGN PATENT DOCUMENTS

	Document Number Country Code-Number-Kind Code	Date MM-YYYY ¹	Country	Name	Classification ²	
N	106,196	5/1987	Japan	Kurokawa	184	6.4
O	3,943,191	12/1986	Russia	Shvartsman	----	----
P						
Q						
R						
S						
T						

NON-PATENT DOCUMENTS

	Include, as applicable: Author, Title, Date, Publisher, Edition or Volume, Pertinent Pages
U	
V	
W	
X	

¹ A copy of this reference is not being furnished with this Office action. See MPEP § 707.05(a).

¹ Dates in MM-YYYY format are publication dates.

² Classifications may be U.S. or foreign.

NOTICE OF DRAFTSPERSON'S
PATENT DRAWING REVIEWThe drawing(s) filed (insert date) 7/14/04 are:A. ☐ approved by the Draftsperson under 37 CFR 1.84 or 1.152.B. ☒ objected to by the Draftsperson under 37 CFR 1.84 or 1.152 for the reasons indicated below. The Examiner will require submission of new, corrected drawings when necessary. Corrected drawing must be submitted according to the instructions on the back of this notice.DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings:
Black ink. Color.☐ Color drawings are not acceptable until petition is granted.☐ Fig(s) _____☐ Pencil and non black ink not permitted. Fig(s) _____

2. PHOTOGRAPHS. 37 CFR 1.84 (b)

☐ 1 full-tone set is required. Fig(s) _____☐ Photographs not properly mounted (must use bristol board or

photographic double-weight paper). Fig(s) _____

☐ Poor quality (half-tone). Fig(s) _____

3. TYPE OF PAPER. 37 CFR 1.84(c)

☐ Paper not flexible, strong, white, and durable.☒ Fig(s) _____☒ Erasures, alterations, overwritings, interlineations,folds, copy machine marks not accepted. Fig(s) 1-5☐ Mylar, velum paper is not acceptable (too thin).☐ Fig(s) _____

4. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable sizes:

☐ 21.0 cm by 29.7 cm (DIN size A4)☐ 21.6 cm by 27.9 cm (8 1/2 x 11 inches)☐ All drawing sheets not the same size.☐ Sheet(s) _____☐ Drawings sheets not an acceptable size. Fig(s) _____

5. MARGINS. 37 CFR 1.84(g): Acceptable margins:

Top 2.5 cm Left 2.5cm Right 1.5 cm Bottom 1.0 cm

SIZE: A4 Size

Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm

SIZE: 8 1/2 x 11

☐ Margins not acceptable. Fig(s) _____☐ Top (T) _____ Left (L)☐ Right (R) _____ Bottom (B)

6. VIEWS. 37 CFR 1.84(h)

REMINDER: Specification may require revision to correspond to drawing changes.

Partial views. 37 CFR 1.84(h)(2)

☐ Brackets needed to show figure as one entity.☐ Fig(s) _____☐ Views not labeled separately or properly.☐ Fig(s) _____☐ Enlarged view not labeled separately or properly.☐ Fig(s) _____

7. SECTIONAL VIEWS. 37 CFR 1.84 (h)(3)

☐ Hatching not indicated for sectional portions of an object.☐ Fig(s) _____☐ Sectional designation should be noted with Arabic or

Roman numbers. Fig(s) _____

8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)

☐ Words do not appear on a horizontal, left-to-right fashion when page is either upright or turned so that the top becomes the right side, except for graphs. Fig(s) _____

9. SCALE. 37 CFR 1.84(k)

☐ Scale not large enough to show mechanism without crowding when drawing is reduced in size to two-thirds in reproduction.☐ Fig(s) _____

10. CHARACTER OF LINES, NUMBERS, & LETTERS.

37 CFR 1.84(i)

☒ Lines, numbers & letters not uniformly thick and well defined, clean, durable, and black (poor line quality).☐ Fig(s) 1-5

11. SHADING. 37 CFR 1.84(m)

☐ Solid black areas pale. Fig(s) _____☐ Solid black shading not permitted. Fig(s) _____☐ Shade lines, pale, rough and blurred. Fig(s) _____

12. NUMBERS, LETTERS, & REFERENCE CHARACTERS.

37 CFR 1.84(p)

☒ Numbers and reference characters not plain and legible.☐ Fig(s) _____☒ Figure legends are poor. Fig(s) 1-5☐ Numbers and reference characters not oriented in the

same direction as the view. 37 CFR 1.84(p)(1)

☐ Fig(s) _____☐ English alphabet not used. 37 CFR 1.84(p)(2)☐ Figs _____☐ Numbers, letters and reference characters must be at least

.32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3)

☐ Fig(s) _____

13. LEAD LINES. 37 CFR 1.84(q)

☐ Lead lines cross each other. Fig(s) _____☐ Lead lines missing. Fig(s) _____

14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.84(t)

☐ Sheets not numbered consecutively, and in Arabic numerals beginning with number 1. Sheet(s) _____

15. NUMBERING OF VIEWS. 37 CFR 1.84(u)

☐ Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig(s) _____☐ Fig(s) _____

16. CORRECTIONS. 37 CFR 1.84(w)

☐ Corrections not made from prior PTO-948☐ dated _____

17. DESIGN DRAWINGS. 37 CFR 1.152

☐ Surface shading shown not appropriate. Fig(s) _____☐ Solid black shading not used for color contrast.☐ Fig(s) _____

COMMENTS

REVIEWER _____ DATE _____ TELEPHONE NO. _____

ATTACHMENT TO PAPER NO. _____

DERWENT-ACC-NO: 1987-205134

DERWENT-WEEK: 198729

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**TITLE: Evaluation device of oil lubricating
characteristic - has optical
sensor to fix movement of separator under
friction and uses control mechanism
reset separator**

**INVENTOR: SHVARTSMAN, V S H;
VERESNYAK, V P**

**PATENT-ASSIGNEE: BAKASHVILI D
L[BAKAI]**

**PRIORITY-DATA: 1985SU-3943191 (August
6, 1985)**

PATENT-FAMILY:

PUB-NO	PUB-DATE	
LANGUAGE	PAGES	MAIN-IPC
SU 1276954 A	December 15, 1986	
N/A	003	N/A

APPLICATION-DATA:

PUB-NO	APPL-DESCRIPTOR
APPL-NO	APPL-DATE
SU 1276954A	N/A
1985SU-3943191	August 6, 1985

INT-CL_(IPC): G01N011/00**ABSTRACTED-PUB-NO: SU 1276954A**

BASIC-ABSTRACT: Test lubricant is applied to the bearing, loading is applied directions, with a light flow being directed onto ball bearings (9) and onto the lower surface of ring (7) with a semi-transparent coating. Reflected beams

**interfere and form an interference pattern,
used to determine the oil film
thickness according to the number of
interference bands at the contact.
Friction moves separator (10) from its
initial position which is registered by
optical sensor (12), the signal from which
is registered and passes to a
control mechanism, resetting separator
(10).**

**USE - Determination of characteristics of
lubricants. Bul.46/ 15.12.86**

CHOSEN-DRAWING: Dwg.1/1

TITLE-TERMS:

**EVALUATE DEVICE OIL LUBRICATE
CHARACTERISTIC OPTICAL SENSE FIX
MOVEMENT
SEPARATE FRICTION CONTROL
MECHANISM RESET SEPARATE**

DERWENT-CLASS: S02 S03

**EPI-CODES: S02-A02B2; S02-A03B2;
S03-F03;**

SECONDARY-ACC-NO:

**Non-CPI Secondary Accession Numbers:
N1987-153297**



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,044	05/17/2001	Masaaki Sekine	Q64486	3968

7590

03/31/2003

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, NW
Washington, DC 20037-3213

EXAMINER

BAREFORD, KATHERINE A

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 03/31/2003

DOCKETED

APR 02 2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

09/859,044

Applicant(s)

SEKINE ET AL.

Examiner

Katherine A. Bareford

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers Claims 13-18 are canceled.

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The amendment of Feb. 24, 2003 has been received and entered.

Election/Restrictions

(Claims 1-8)

2. Applicant's election of Group I in Paper No. 7 (Feb. 24, 2003) is acknowledged.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

3. Claims 9-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7 (Feb. 24, 2003).

Claim Objections

4. The Examiner notes that claims 3, 7 and 23 indicate that "said discharge port is performed with an oil repellent treatment". The Examiner understands this to correspond to the teaching in the specification at page 12, lines 25-27, that "an oil repellent treatment is carried out on radially outer surfaces of the oil feed pipes 7". However, it would be better to word the claim as "said discharge port has been treated with an oil repellent" so as to provide a more grammatically clear term.

The Examiner further notes that in claims 1 and 21 it is indicated that the discharge port is located "sufficiently close to a rolling element". The Examiner understands this phrase to mean that the port is located "sufficiently close" to the rolling element so that the described transfer of lubricant can occur. If applicant disagrees, the claims should be clarified.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-8 and 19-24 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and 5 as amended and new claim 21 all require that an the process be part of "an automated production line" (see claim 1, line 5; claim 5, line 4; and claim 21, line 2).
However, applicant has provided no indication of where support for this "automated production line" is provided in the originally filed disclosure and a review of the disclosure by the Examiner provides no basis for this term.

The other dependent claims do not cure the defects of the claims from which they depend.

Response to Arguments

Reverse
p 21
line 11-22

7. Applicant's arguments with respect to claims 1-8 and 19-24 have been considered but are moot in view of the new ground(s) of rejection.

8. As to claims 1-8 and 19-20, the Examiner notes that Johnstone et al (US 4527661) teaches providing a mist of oil or oil/air onto a rolling bearing from a discharge port. However, Johnstone does not ^{teach} ~~teach~~ or suggest the use of a holding/rotary table as part of an automated production line as required by present claims 1 and 5.

As to claims 21-24, the Examiner notes that Johnstone et al (US 4527661) teaches providing a mist of oil or oil/air onto a rolling bearing from a discharge port. Momono et al (US 5443317) teaches the well known provision of a crown shaped retainer for a rolling bearing (see column 1, lines 35-50). However, neither Johnstone or Momono, alone or in combination, teaches or suggests the application of the lubricant to a rolling bearing in an automated production line using a discharge port system as claimed by claim 21.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until


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after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (703) 308-0078. The examiner can normally be reached on M-F(7:00-4:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


KATHERINE A. BAREFORD
PRIMARY EXAMINER
GROUP 1100/1700

Notice of References Cited

Application/Control No.

09/859,044

Applicant(s)/Patent Under
Reexamination
SEKINE ET AL.

Examiner

Katherine A. Bareford

Art Unit

1762

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,443,317	08-1995	Momono et al.	384/491
	B	US-4,527,661	07-1985	Johnstone et al.	184/6.1
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

SEP 10 2002

PTO/SB/08 A & B (modified)

Substitute for Form 1449 A & B/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANTS

(use as many sheets as necessary)

Complete if Known

Application Number	09/859,044
Confirmation Number	3968
Filing Date	May 17, 2001
First Named Inventor	Masaaki SEKINE
Art Unit	2856
Examiner Name	Not Yet Assigned Bareford
Attorney Docket Number	Q64486

Sheet 1 of 1

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document
		Number	Kind Code ² (if known)		
VB		US 4,152,598		05/01/1979	STEWART
VB		US 4,738,336		04/19/1988	SMITH et al.
VB		US 5,076,397		12/31/1991	YAMADA
VB		US 6,324,899	B1	12/04/2001	DISCENZO
		US			
		US			
		US			
		US			
		US			

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FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document			Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Translation ⁶
		Country Code ³	Number ⁴	Kind Code ⁵ (if known)			
VB		JP	62-106196		05-16-1987	KUROKAWA	Abstract
VB		SU	3943191		12-15-1986	SHVARTSMAN, et al.	Abstract

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city, and/or country where published.	Translation ⁶

Examiner Signature	H. Bareford	Date Considered	3/20/03
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov, MPEP 901.04 or in the comment box of this document. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST. 3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to indicate here if English language Translation is attached.



Substitute for Form 1449 A & B/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANTS

(use as many sheets as necessary)

Complete if Known

Application Number	09/859,044
Confirmation Number	3968
Filing Date	May 17, 2001
First Named Inventor	Masaaki SEKINE
Art Unit	1762
Examiner Name	Rebecca A. BLANTON Bareford
Attorney Docket Number	Q64486

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Document Number		Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document
		Number	Kind Code ² (if known)		
VB		US 4,256,591		03-17-1981	YAMAMOTO et al.
VB		US 5,021,665		06-04-1991	AMES
VB		US 5,412,219		05-02-1995	CHAPPELLE et al.
VB		US 5,950,588		09-14-1999	KUSCHE et al.
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FOREIGN PATENT DOCUMENTS

[illegible]

OTHER PRIOR ART - NON PATENT LITERATURE DOCUMENTS

[illegible]

Examiner Signature	K. Bareford	Date Considered	3/20/03
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² See Kind Codes of USPTO Patent Documents at www.uspto.gov, MPEP 901.04 or in the comment box of this document. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST. 3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to indicate here if English language Translation is attached.



FEB 20 2003

Commissioner for Patents
Washington, DC 20231
www.uspto.gov

Dear Patent Business Customer:

The United States Patent and Trademark Office ("Office") is now permitting and encouraging applicants to voluntarily submit amendments in a revised format as set forth in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, ___ *Off. Gaz. Pat. Office* ___ (February 25, 2003), currently available on the USPTO web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>. The revised format permits amendments to the specification and claims to be made in a single marked-up version: the requirement for a clean version is eliminated. Attached, you will find a flyer with information and instructions regarding the procedures to be used to comply with the revised format. The flyers are being inserted with out-going Office actions mailed during the period of February 20, 2003 - March 31, 2003.

The revised amendment format is essentially the same as the amendment format for the specification, claims, and drawings that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. This proposed revision and others necessary to facilitate a gradual transition to the use of an Electronic File Wrapper (EFW) will be set forth in a Notice of Proposed Rule making (NPR), expected to be published by March 2003. After consideration of public comments, the Office anticipates adopting a revision to § 1.121, following publication of a Notice of Final Rule making (NFR), expected by June 2003, at which point compliance with revised § 1.121 will be mandatory.

The Office will continue to accept your amendment submissions in the revised format during the voluntary period, which will extend up to the effective date of final revisions to § 1.121. The Office also encourages your feedback on the proposed revised amendment format and other changes set forth in the NPR, expected to be published by March 2003.

For assistance: Any questions regarding the submission of amendments pursuant to the revised practice should be directed to Office of Patent Legal Administration (OPLA), Legal Advisors Elizabeth Dougherty (Elizabeth.Dougherty@uspto.gov), Gena Jones (Eugenia.Jones@uspto.gov) or Joe Narcavage (Joseph.Narcavage@uspto.gov). Alternately, you may send e-mail to "Patent Practice", the OPLA e-mail address that has been established for receiving queries and questions about patent practice and procedures or telephone OPLA at (703) 305-1616.

A handwritten signature in black ink, reading "Nicholas P. Godici".

Nicholas P. Godici
Commissioner for Patents

Attachment: Flyer entitled: *Revised Notice* AMENDMENTS MAY NOW BE SUBMITTED IN REVISED FORMAT*

Revised Notice*

AMENDMENTS MAY NOW BE SUBMITTED IN REVISED FORMAT

The United States Patent and Trademark Office (USPTO) is permitting applicants to submit amendments in a revised format as set forth below. Further details of this practice are described in *AMENDMENTS IN A REVISED FORMAT NOW PERMITTED*, signed January 31, 2003, expected to be published in *Official Gazette* on February 25, 2003 (Notice posted on the Office's web site at <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtprac.htm>). The revised amendment format is essentially the same as the amendment format that the Office is considering adopting via a revision to 37 CFR 1.121 (Manner of Making Amendments). The revision to 37 CFR 1.121 (if adopted) will simplify amendment submission and improve file management. The Office plans to adopt such a revision to 37 CFR 1.121 by July of 2003, at which point compliance with revised 37 CFR 1.121 will be mandatory.

Effective immediately, **all** applicants may submit amendments in reply to Office actions using the following format. Participants in the Office's electronic file wrapper prototype¹ receiving earlier notices of the revised practice may also employ the procedures set out below.

REVISED FORMAT OF AMENDMENTS

Begin on separate sheets:

Each section of an Amendment (e.g., Claim Amendments, Specification Amendments, Drawing Amendments, and Remarks) should begin on a separate sheet. *For example*, in an amendment containing a.) introductory comments, b.) amendments to the claims, c.) amendments to the specification, and d.) remarks, each of these sections must begin on a separate sheet. This will facilitate the process of separately indexing and scanning of each part of an amendment document for placement in an electronic file wrapper.

Two versions of amended part(s) no longer required:

The current requirement in 37 CFR 1.121(b) and (c) to provide two versions (a clean version and a marked up version) of each replacement paragraph, section or claim will be waived where an amendment is submitted in revised format below. The requirements for substitute specifications under 37 CFR 1.125 will be retained.

A) Amendments to the claims:

Each amendment document that includes a change to an existing claim, or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number, the status must be indicated in a parenthetical expression, and the text of each claim under examination (with markings to show current changes) must be presented. The listing will serve to replace all prior versions of the claims in the application.

- (1) The current status of all of the claims in the application, including any previously canceled or withdrawn claims, must be given. Status is indicated in a parenthetical expression following the claim number by one of the following: (original), (currently amended), (previously amended), (canceled), (withdrawn), (new), (previously added), (reinstated – formerly claim #_), (previously reinstated), (re-presented – formerly dependent claim #_), or (previously re-presented). The text of all pending claims under examination must be submitted each time any claim is amended. Canceled and withdrawn claims should be indicated by only the claim number and status.
- (2) All claims being currently amended must be presented with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim should be shown by strikethrough (for deleted matter) or underlining (for added matter). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended" will include markings.
- (3) The text of pending claims not being amended must be presented in clean version, i.e., without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version.

¹ The Office's Electronic File Wrapper prototype program is described in *USPTO ANNOUNCES PROTOTYPE OF IMAGE PROCESSING*, 1265 *Off. Gaz. Pat. Office* 87 (Dec. 17, 2002) ("Prototype Announcement"), and applies only to Art Units 1634, 2827 and 2834.

- (4) A claim may be canceled by merely providing an instruction to cancel. Listing a claim as canceled will constitute an instruction to cancel. Any claims added by amendment must be indicated as (new) and shall not be underlined.
- (5) All of the claims in each amendment paper must be presented in ascending numerical order. Consecutive canceled or withdrawn claims may be aggregated into one statement (e.g., Claims 1 – 5 (canceled)).

Example of listing of claims (use of the word “claim” before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (withdrawn)

Claim 7 (previously amended): A bucket with a handle.

Claim 8 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 9 (withdrawn)

Claim 10 (original): The bucket of claim 8 with a wooden handle.

Claim 11 (canceled)

Claim 12 (re-presented – formerly dependent claim 11) A black bucket with a wooden handle.

Claim 13 (previously added): A bucket having a circumferential upper lip.

Claim 14 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification must be made by presenting a replacement paragraph or section marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per current 37 CFR 1.125.

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with § 1.84. An explanation of the changes made must be presented in the remarks section of the amendment. Any replacement drawing sheet must include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing should **not** be labeled as “amended.” If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Any questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to the following legal advisors in the Office of Patent Legal Administration (OPLA): Elizabeth Dougherty (Elizabeth.Dougherty@uspto.gov), Gena Jones (Eugenia.Jones@uspto.gov) or Joe Narcavage (Joseph.Narcavage@uspto.gov). For information on the waiver or legal aspects of the prototype, please contact Jay Lucas (Jay.Lucas@uspto.gov), Senior Legal Advisor (PCTLA) or Rob Clarke (Robert.Clarke@uspto.gov), Senior Legal Advisor (OPLA). Alternatively, further information may be obtained by calling OPLA at (703) 305-1616.

* Revised Notice: See Sec. B) for changes relating to substitute specifications, and Sec. C) for changes on replacement drawing practice.